

REMARKS

Reconsideration of the present application is respectfully requested. Claims 1-19 and 58-78 were pending. Claims 1, 9-14, 17-19, 58, 65, 67, and 76 have been amended. Claims 62, 63, 68-72 have been canceled. No claims have been added. No new matter has been introduced as a result of the amendments. Thus, claims 1-19, 58-61, 64-67, and 73-79 remain pending.

The Applicants respectfully submit that the amendments to claims 1, 9-14, 17-19, 58, 65, 67, and 76 require no new prior art search. The amendments clarify that the third party is a third party supplier consistent with the claimed subject matter previously searched and examined by the Examiner. By clarifying that the third party is a third party supplier, the Applicants submit that no new issues which would require an additional prior art search have been raised.

The Examiner objected to the specification citing the use of trademarks in the specification. The Applicants have accordingly amended the specification to preserve the proprietary nature of the marks to avoid any adverse effects as to the validity of the marks. The Applicants respectfully request withdrawal of the objections.

The Examiner rejected claims 1-19, 58-61, 64-67, and 73-79 under 35 U.S.C. §112, first paragraph, for introducing matter into the claims which was not described in the specification. Although Applicants do not admit that this is the case, Applicants have amended claims 1 and 58 to remove the noted subject matter and request withdrawal of the rejections. The subject matter objected to, however, is not present in independent claims 67 or 76, and therefore request withdrawal of the rejections of claims 67 and 76. Because claims 2-19, 59-61, 64-66, 73-75, and 77-79 are dependent

on claims 1, 58, 67, or 76, and were rejected based on their dependency from claims 1, 58, 67, and 76, the Applicants request withdrawal of the rejections.

The Examiner has withdrawn claims 62, 63, and 68-72 from consideration stating the claims are directed to a non-elected invention. The Applicants have accordingly cancelled claims 62, 63, and 68-72.

The Examiner rejected claims 1-4, 7, 8, 11, 13, 16, 58-61, 67, and 76-79 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,017,157 of Garfinkle et al. (hereinafter "Garfinkle") in view of U.S. Pat. App. Pub. No. 2004/0138962 of Kopelman et al. (hereinafter "Kopelman").

Garfinkle describes a method for processing print and digital images of a photographer (Garfinkle, Abstract; Column 1, line 59 to Column 2, line 4). Print photographs are scanned from a roll of film and corresponding digital images are transferred/uploaded to a server by a photographer (Garfinkle, Column 2, lines 43-64). An access code is described that identifies the photographer's digital images, as well as particular image server where the images are stored (Garfinkle, Column 4, lines 6-20). The photographer may then order print copies of the uploaded digital images from a pre-selected fulfillment center utilizing the photographer's access code (Garfinkle, Column 9, lines 8-13; Column 9, lines 26-41).

Kopelman describes a method and apparatus for pricing used goods of independent seller's (Kopelman, Abstract). When a seller wishes to sell an item in a virtual marketplace, the seller registers the item with a marketer (e.g., the marketplace website) (Kopelman, Figure 2; paragraphs 0035-0036). The seller registers the item by entering a standard UPC or ISBN number for the item at the virtual marketplace

(Kopelman, paragraph 0035). The registration associates the standard code for the item with a record for the seller (Kopelman, paragraph 0035). The virtual marketplace then generates an index price for the seller's registered item that is adjustment to reflect a value for the item (Kopelman, paragraph 0036). Furthermore, the seller need not be identified by the virtual marketplace before a sale (Kopelman, Figure 1). When a buyer does decide to purchase an item from a seller, the virtual marketplace either introduces the buyer and seller so they can complete the sale directly, redirects each party to a clearinghouse, or acts as the clearinghouse (Kopelman, paragraph 0030).

Claim 1, as amended, claims:

An improved method for an e-commerce retailer to display and sell items of a third party comprising:

identifying one or more items of a third party supplier with a unique identifier;

associating the unique identifier of the item with an image of the item, said image residing on a computer maintained by the third party supplier;

presenting at least some of the images of third party supplier items to a user for on-line commerce, said images being retrieved from said computer maintained by the third party supplier;

in response to an order request from the user for one or more items, identifying, based at least in part on said unique identifier, each item requested and an appropriate third party supplier for each requested item;

automatically generating an order for each requested item to be transparently sent to the third party supplier.

Garfinkle describes a system that associates an identifier with a photographer's images.

The photographer then uses the identifier associated with his images to order copies of those images from a pre-selected fulfiller. Therefore, the identifier described by Garfinkle identifies the photographer's digital images associated with the photographer's digital images, and not items of the pre-selected fulfiller. Therefore, Garfinkle fails to

describe or suggest “identifying one or more items of a third party supplier with a unique identifier” since Garfinkle utilizes an identifier for the photographer’s images, but not a third party supplier.

Furthermore, the Examiner asserted that Garfinkle discloses “identifying one or more items of a third party with a unique identifier” and noting that “the item is a digital image and the third party is the photographer” (Office Action, mailed 5/3/2006, page 6). The Examiner then asserted that “presenting at least some of the images of third party items [i.e., the photographer’s digital images] to a user for on-line commerce ... said images being retrieved from said computer maintained by the third party” and noting that “the retrieval of images is using the upload interface to transfer data” (Office Action, mailed 5/3/2006, page 6). However, orders are explicitly taught as being placed by the photographer (Garfinkle, column 7, lines 43-52). The photographer cannot be both the user and the third party, as proposed by the Examiner. According to the Examiner’s argument, when “in response to an order request ... automatically generating an order for each requested item to be transparently sent to the third party,” the photographer places an order for his own photographs with himself. It does not make logical sense for the photographer of Garfinkle to place an order with himself for his photographs.

The Applicants recite, in claim 1, “identifying one or more items of a third party supplier with a unique identifier,” “presenting at least some of the images of third party supplier items to a user,” and then “in response to an order request from the user ... automatically generating an order for each requested item to be transparently sent to the third party supplier.” The user, as claimed in claim 1, is distinct from the third party, because a user places an order with the e-commerce retailer, which is then sent to the

third party. The Examiner cannot concatenate the user and third party into a single entity. Therefore, Garfinkle fails to teach or suggest “identifying one or more items of a third party supplier with a unique identifier,” “presenting at least some of the images of third party supplier items to a user,” and then “in response to an order request from the user ... automatically generating an order for each requested item to be transparently sent to the third party supplier,” as claimed by the applicants in claim 1.

Furthermore, Kopelman describes identifying seller merchandise utilizing a standard UPC or ISBN code, not a unique identifier for third party items. That standard code is then associated with a record for the seller, but not the seller’s items. Kopelman is completely silent as to the seller maintaining images of their items for use in conducting a sales transaction. Furthermore, once a sales transaction begins, the parties are introduced to each other or the sale is facilitated through a clearinghouse, but orders are not described as being sent to the third party. As such, Kopelman also fails to describe or suggest “identifying one or more items of a third party supplier with a unique identifier,” “presenting at least some of the images of third party supplier items to a user,” and then “in response to an order request from the user ... automatically generating an order for each requested item to be transparently sent to the third party supplier,” as claimed by the applicants in claim 1.

Because neither reference, alone or in combination, teaches or suggests the elements as claimed by the Applicants in claim 1, the Applicants submit that Garfinkle in view of Kopelman fails to render claim 1 obvious. Since claims 2-4, 7, 8, 11, 13, and 16 depend from claim 1, and add additional features and limitations, claims 2-4, 7, 8, 11,

13, and 16 are also not rendered obvious by Garfinkle in view of Kopelman. The Applicants respectfully request withdrawal of the rejections.

Claim 58, as amended, claims:

A system providing an improved method for an e-commerce retailer to display and sell items of a third party, said system comprising:
an e-commerce retailer to identify an item of a third party supplier with a unique identifier;
an image server module for receiving user information requests from the e-commerce retailer regarding certain third party supplier items, and transparently providing images and descriptions of said items; and
an order engine module, in communication with said image server module, for processing orders for third party supplier items.

As discussed above, with respect to claim 1, neither Garfinkle nor Kopelman, alone or in combination teach or suggest identifying and selling third party items in a transparent manner to a user through an e-commerce retailer. Therefore, for similar reasons to those discussed above with respect to claim 1, Garfinkle and Kopelman, alone or in combination, also fail to render claim 58 obvious. Furthermore, claims 59-61 depend on claim 58, and include additional features and limitations. Thus, claims 59-61 are also not rendered obvious under Garfinkle in view of Kopelman.

Claim 67, as amended, claims:

An improved e-commerce system for providing products and services of third parties, said system comprising:
a computer implemented program logic to transparently present third party supplier items to a user for on-line commerce;
computer-implemented program logic for receiving user information requests regarding certain graphic images from an item presentation program logic, and providing digital images for display; and
computer-implemented program logic for processing orders for graphic images to be transparently sent to the appropriate third party supplier.

As discussed above, with respect to claim 1, neither Garfinkle nor Kopelman, alone or in combination teach or suggest identifying and selling third party items in a transparent manner to a user through an e-commerce retailer. Therefore, similarly to the reasons discussed above with respect to claim 1, Garfinkle and Kopelman, alone or in combination, also fail to render claim 67 obvious.

Claim 76 claims:

A system comprising:
a tagging logic to identify one or more items of a third party supplier with unique identifiers, each unique identifier associated with data about that item;
an e-commerce logic to transparently present at least some of the items to a user for on-line commerce;
an XML request logic to retrieve the data about the one or more items from a third party supplier website, and enabling the e-commerce logic to present the data to the user for the on-line commerce; and
an order engine to process orders for items.

As discussed above, with respect to claim 1, neither Garfinkle nor Kopelman, alone or in combination teach or suggest identifying and selling third party items in a transparent manner to a user through an e-commerce retailer. Furthermore, neither Garfinkle nor Kopelman discuss utilizing XML, as Garfinkle merely discusses using HTML forms (Garfinkle, column 5, lines 11-20) and Kopelman does not suggest any specific implementations. Therefore, similarly to the reasons discussed above with respect to claim 1, and including the noted limitation directed to XML, Garfinkle and Kopelman, alone or in combination, also fail to render claim 76 obvious. Furthermore, claims 77-79 depend on claim 76, and include additional features and limitations. Thus, claims 77-79 are also not rendered obvious under Garfinkle in view of Kopelman.

The Examiner rejected claims 5, 9, 10, 12, 17, 64, and 75 under 35 U.S.C. § 103(a) as being unpatentable over Garfinkle in view of Kopelman, and further in view of

Pat. App. Pub. No. US 2002/0065741 A1 of Baum (hereinafter "Baum"). The Applicants do not admit that Baum is prior art and reserve the right to swear behind the reference at a later date.

The Applicants respectfully submit that neither Garfinkle, nor Baum, alone or in combination, teach or suggest each and every feature as claimed in claims 5, 9, 10, 12, 17, 64, and 75. As discussed above, with respect to the independent claims, Garfinkle and Kopelman, alone or in combination fail to describe or suggest identifying and selling third party items in a transparent manner to a user through an e-commerce retailer. Baum describes a user initiating the distribution of cards from a selected service, where the cards include an image and text associated with the image (Baum, page 8, paragraphs 78-80; Figure 4). Thus, because Baum merely discusses distributing e-cards, Baum also fails to describe or suggest identifying and selling third party items to a user through an e-commerce retailer. Therefore, since neither Garfinkle, Kopelman, nor Baum, alone or in combination, teaches or suggests the limitations of the independent claims, claim 1 is not rendered obvious by Garfinkle in view of Kopelman and further in view of Baum. Furthermore, claims 5, 9, 10, 12, and 17, 64, and 75 respectively depend on claims 1, 58, and 67, and include additional features and limitations. Thus, claims 5, 9, 10, 12, 17, 64, and 75 are also not rendered obvious by Garfinkle in view of Baum.

The Examiner rejected claims 6 and 14 under 35 U.S.C. § 103(a) as being unpatentable over Garfinkle in view of Kopelman, and further in view of Pat. App. Pub. No. US 2002/0077937 A1 of Lyons et al. (hereinafter "Lyons"). The Applicants do not admit that Lyons is prior art and reserve the right to swear behind the reference at a

later date. With respect to claim 1, as discussed above, the combination of Garfinkle and Kopelman fail to describe or suggest identifying and selling third party items in a transparent manner to a user through an e-commerce retailer. Lyons describes a system where a user buys goods online and picks up goods at a selected pickup location (Lyons, Abstract; page 6, paragraphs 50-52). If the goods are available at a pickup location, a message is sent to the seller indicating that such goods are available (Lyons, page 5, paragraph 50). However, Lyons does not address transparently providing third party items in this system, as a buyer must select a pickup location when buying goods. Thus, Lyons also fails to describe or suggest identifying and selling third party items to a user through an e-commerce retailer, as discussed with respect to claim 1. Therefore, since none of the references, alone or in combination, teaches or suggests the limitations of claim 1, claim 1 is not rendered obvious by Garfinkle in view of Kopelman and further in view of Lyons. Furthermore, claims 6 and 14 depend on claim 1, and include additional features and limitations. Thus, claims 6 and 14 are also not rendered obvious by Garfinkle in view of Kopelman and further in view of Lyons.

The Examiner rejected claim 15 under 35 U.S.C. § 103(a) as being unpatentable over Garfinkle in view of Kopelman, and further in view of Pat. App. Pub. No. US 2002/0143637 A1 of Shmueli et al. (hereinafter "Shmueli"). The Applicants do not admit that Shmueli is prior art and reserve the right to swear behind the reference at a later date. The Applicants respectfully submit that neither Garfinkle, Kopelman, nor Shmueli, alone or in combination, teach or suggest each and every feature as claimed in claim 15. With respect to claim 1, as discussed above, Garfinkle and Kopelman fail to describe or suggest identifying and selling third party items in a transparent manner to a

user through an e-commerce retailer. Shmueli describes a system for facilitating multiple shopping sessions at multiple websites with a portable device that retains and utilizes information from the multiple shopping sessions (Shmueli, page 6, paragraphs 61-65). However, Shmueli does not address a site which transparently sells third party goods since Shmueli merely describes a device which retains information for multiple shopping sessions. Thus, Shmueli also fails to describe or suggest identifying and selling third party items in a transparent manner to a user through an e-commerce retailer. Therefore, since neither reference, alone or in combination, teaches or suggests the limitations of claim 1, claim 1 is not rendered obvious by Garfinkle in view of Kopelman and further in view of Shmueli. Furthermore, claim 15 depends on claim 1, and includes additional features and limitations. Thus, claim 15 is also not rendered obvious by Garfinkle in view of Shmueli.

The Examiner rejected claims 18, 19, 65, 66, 73, and 74 under 35 U.S.C. § 103(a) as being unpatentable over Garfinkle in view of Kopelman, and further in view of U.S. Patent No. 6,505,172 of Johnson et al. (hereinafter "Johnson"). The Applicants respectfully submit that neither Garfinkle, Kopelman, nor Johnson, alone or in combination, teach or suggest each and every feature as claimed in claims 18, 19, 65, 66, 73, and 74. With respect to the independent claims, as discussed above, Garfinkle and Kopelman fail to describe or suggest identifying and selling third party items to a user through an e-commerce retailer. Johnson describes generating purchase orders that are forwarded to numerous warehouse locations for satisfaction from warehouse inventory (Johnson, Figure 3). However, warehouse inventory location is transmitted back to a purchaser (Johnson, column 10, lines 50-55), and Johnson does not address

transparently presenting third party items. Thus, Johnson also fails to describe or suggest identifying and selling third party items to a user through an e-commerce retailer. Therefore, since none of the references, alone or in combination, teach or suggest the limitations of claim 1, claim 1 is not rendered obvious by Garfinkle in view of Kopelman and further in view of Johnson. Furthermore, claims 18-19, 65-66, and 73-74 depend on claims 1, 58, and 67, respectively, and includes additional features and limitations. Thus, claims 18, 19, 65, 66, 73, and 74 are also not rendered obvious by Garfinkle in view of Kopelman and further in view of Johnson.

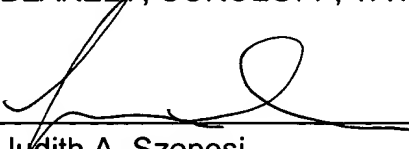
If a telephone interview would expedite the prosecution of this application, the Examiner is invited to contact Judith Szepesi at (408) 720-8300.

If there are any additional charges/credits, please charge/credit our deposit account no. 02-2666.

Respectfully submitted,
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